

**D. REMARKS**

Claims 1-4, 7-10, 13-16, 19-24 remain pending. Claims 1, 9, 10, 15, 21, 23, 24 have been amended herein. Claim 9 has been rewritten in independent form.

Applicants appreciate the level of detail that the Examiner has put forth in examining this application for patent.

However, the Federal Circuit has repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Furthermore, the combination must teach or suggest all of Applicant's claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The examiner has rejected claims 1-4, 7-10, 13-16 and 19-24 under 35 USC 103(a) as being unpatentable over Olah et al. (hereinafter "Olah" US 6,445,119 B1) in view of Pavley et al. (hereinafter "Pavley", US 6,317,141 B1). Olah teaches saving screen captures to a log. Olah is not storing actual multimedia objects, but merely a screen capture of an instance in time of what is being displayed. Therefore, Olah is not relevant art and does not teach Applicants' claimed invention. Furthermore, the examiner admits that Olah does not disclose displaying the chronological list with control buttons.

The examiner relies on Pavley for creating a slide show for the captured screen images. Pavley discloses using a presentation program such as Microsoft Powerpoint to which images and video may be imported. A combination of Olah and Pavley would

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result in a Powerpoint presentation of captured screen images and not in Applicants' claimed invention of "displaying a chronological list (where the chronological list is made from storing a plurality of multimedia objects each containing at least one transient message) with control button for subsequently rendering the stored multimedia objects in a forward and backward succession." As such, neither Olah nor Pavley, alone or in combination, teach or suggest each and every claim limitation of Applicants' claimed invention, and therefore Applicants' claimed invention is not obvious.

The dependent claims are likewise not obvious for the reasons stated above for the claims from which they depend. Furthermore, claim 9, which was a dependent claim, but has been rewritten as an independent claim to include all the limitations from which it depended, is not obvious for further reasons. Since Olah does not teach capturing multimedia objects, there is no need for Olah to download a software unit and the multimedia object from the server to play the software in response to a selection of a replay button displayed at the client in an area of a document allocated to the multimedia object. Neither Olah, nor Pavley, alone or in combination, nor any other art known to Applicants displays a replay button for selection at the client in an area of a document allocated to the multimedia object, and in response to the selection of the replay button, to download the next sequential multimedia object from the chronological list stored at the server along with a software unit to play it. Applicants admit that it is known to download a multimedia object along with a software unit in response to a selection of a link associated with the multimedia object. But in Applicant's claimed invention, the object

comes from the chronological list that was stored at the server and in response to a replay button displayed at the client. Furthermore, in Applicants' claimed invention, a replay button is selected to initiate the downloading and replaying, and not the selection of a link for a specific object. Thus, claim 9 is also not taught or suggested by the art for reasons in addition to the reasons given above for the independent claims.

The examiner has rejected claims 21-24 under 35 USC 103(a) as being unpatentable over Engle et al. (hereinafter "Engle" Pub No US 2004/0024640A1 in view of More et al (hereinafter "Moore" Pub No 2001/0039546 A1) and further in view of Pavley et al (hereinafter "Pavley" US 6317141 B1). The examiner uses Engle to show identifying a region associated with a transient message and clipping the region. But Engle does not disclose storing each transient message when each message is initially rendered. So the examiner uses Moore to show this. But Moore does not show that the storing is done in a chronological list. So the examiner uses Engle to show that the storing is according to user-defined criteria including the date the ad was captured (which Applicants do not argue would be a chronological list; but do contend that saving by date in Engle requires a user action so saving in a chronological date is not carried out "independent of a user action" as claimed in Applicants' claimed invention). So basically, the examiner is modifying Engle with Moore after Moore is modified by Engle. Then the examiner utilizes Pavley to find further elements of the claim not shown by Engle or Moore.

It appears that the examiner is relying on hindsight with the benefit of Applicants' disclosure and is also using Applicants' disclosure as a blueprint in identifying references and how each specific reference has to first be modified by another reference before being able to show certain elements. Considering that most inventions are a new combination of old elements, if the criteria used by the examiner in examining this application were to be universally used in determining obviousness, then there would be no patents being issued. A prima facie case of obviousness can not be made if one has to modify a modifying reference and then still add yet a third reference. Such an intricate application of the art should be indicative of *per se* non-obviousness! Regardless, the combination still fails to show storing in a chronological list *independently of a user action*.

Since the examiner has clearly used Applicants' claimed invention as a blueprint, and since the combination of references still fails to teach or suggest all of the claimed limitations, the examiner has not met his burden of making a *per se* obviousness determination. As such, Applicants' claimed invention is not obvious.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

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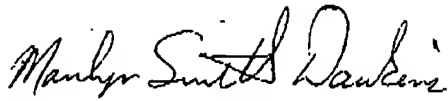
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Marilyn Smith Dawkins  
Attorney for Applicants  
Registration No. 31,140  
(512) 823-0094

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